

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte HERMAN J. MAYEUX,  
and EARL C. RUBY

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Appeal No. 95-0922  
Application 08/082,907<sup>1</sup>

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HEARD: Jun. 8, 1998

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Before KIMLIN, GARRIS, and OWENS, Administrative Patent Judges.  
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the refusal of the  
examiner to allow claims 1 through 7 as amended subsequent to the

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<sup>1</sup> Application for patent filed June 29, 1993. According  
to appellants, this application is a continuation of Application  
07/816,552, filed January 6, 1992, now abandoned.

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final rejection. These are all of the claims remaining in the application.

The subject matter on appeal relates to an almond shell additive for well working fluids consisting essentially of certain particle size fractions of ground almond shells. This appealed subject matter is adequately illustrated by independent claim 1 which reads as follows:

1. An almond shell additive for well working fluids, said additive consisting essentially of ground almond shells consisting essentially of

an intermediate particle fraction having a substantially even particle size distribution between particle sizes of 100 microns and 2000 microns,

a large particle fraction comprising at most about 5 percent by weight of said additive and having a particle size greater than 2000 microns, and

a small particle fraction comprising at least 3 percent and at most 20 percent by weight based on said additive and having a particle size less than 100 microns.

The reference set forth below is relied upon by the examiner in the rejections before us:

Borchardt	2,799,647	July 16, 1957
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Claims 1 through 7 are rejected under the second paragraph of 35 U.S.C. § 112 for failing to particularly point out and distinctly claim the subject matter which the appellants regard as their invention. According to the examiner, claim 1 is

rendered indefinite by the recitation "substantially even... distribution". More specifically, the examiner believes that "[t]he metes and bounds of even-ness have not been set forth so as to establish which distributions are embraced and which are not" (answer, page 2).

Claims 1 through 3, 6 and 7 are rejected under 35 U.S.C. § 102(b) as being anticipated by Borchardt. This rejection is premised upon the examiner's belief that "[t]he specific particle size distribution as claimed herein would be inherent in the Borchardt material" (answer, page 2).

Finally, claims 4 and 5 are rejected under 35 U.S.C. § 103 as being unpatentable over Borchardt based upon the examiner's conclusion that "[i]t would have been obvious to the person having ordinary skill in the art to have used the Borchardt ground almond shells in an oil based drilling fluid because doing so is in clear response to the express suggestion by the patentee" (answer, page 2).

#### OPINION

We cannot sustain any of the above noted rejections.

Concerning the section 112, second paragraph, rejection, the appellants are correct in stating that example 1 of their specification describes a milling operation whereby, "[a]s shown

in Figure 1, a substantially even particle size distribution is achieved for the crushed material for the intermediate particle fraction; i.e. material retained on the U.S. mesh numbers 12 (1680 microns), 16 (1190 microns), 20 (841 microns), 30 (595 microns), 40 (420 microns), 60 (250 microns), 100 (149 microns) and 140 (105 microns)" (specification, page 40). Thus, when reading the claim language and specifically the language "substantially even... distribution" in light of the specification disclosure, we are confident that the metes and bounds of protection circumscribed by the appealed claims would be reasonably precise and particular to one with ordinary skill in the art. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

It follows that we cannot sustain the examiner's rejection of claims 1 through 7 under the second paragraph of 35 U.S.C. § 112.

As for the section 102(b) rejection, we cannot agree with the examiner's aforequoted position that "[t]he specific particle size distribution as claimed herein would be inherent in the Borchardt material". It is apparent that patentee's disclosure at lines 28 through 42 in column 3 of size ranges and quantities for his almond flakes, fibers and granules simply do not

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correspond to the sizes and quantities of the here claimed intermediate, large and small particle fractions. While certain of patentee's size ranges may overlap slightly with certain of the here claimed size ranges, no basis exists for concluding that his material contains the percentages of large and small particle size fractions defined by appealed claim 1. In fact, such a conclusion is contrary to Borchardt's disclosure that his material contains substantial amounts or quantities of the flake, fiber and granule fractions (again see lines 28 through 42 in column 3).

In light of the foregoing, it is clear to us that the examiner's inherency position is unjustified and accordingly that his consequent rejection under 35 U.S.C. § 102(b) of claims 1 through 3, 6 and 7 as being anticipated by Borchardt cannot be sustained.

The above noted section 103 rejection of claims 4 and 5 also cannot be sustained because it is ultimately premised upon the examiner's unacceptable inherency position discussed above.

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CONCLUSION

The decision of the examiner is reversed.

REVERSED

Edward C. Kimlin	)	
Administrative Patent Judge	)	
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Bradley R. Garriss	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
Terry J. Owens	)	
Administrative Patent Judge	)	

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